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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/438,030	11/10/99	IMRAN	M PERCUS.093A

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EXAMINER	
SERKE, C	
ART UNIT	PAPER NUMBER
3763	8

DATE MAILED: 11/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/438,030

Applicant(s)

IMRAN ET AL.

Examiner

Catherine Serke

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 14-30 is/are allowed.
- 6) ☐ Claim(s) 1-5,7 and 13 is/are rejected.
- 7) ☐ Claim(s) 6 and 8-12 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4,5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Information Disclosure Statement*

The information disclosure statements filed 3/14/2000 and 5/2/2000 fail to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. As noted on the copies of the PTO 1449s, most of the patents, foreign patents, and other documents were reviewed. Prior US applications 08/813,807 and 09/049,857 did not have copies of the citations that were lined through. The examiner requests that if applicant wants these citations to be reviewed copies of those documents be submitted with the response to this office action.

### *Claim Rejections - 35 USC § 112*

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Claim 7 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 7 recites the limitation "occlusion" in line 1. There is insufficient antecedent basis for this limitation in the claim. The examiner suggests changing the limitation to --occlusive substance-- to maintain consistency with claim 3 from which it depends.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-4 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by Frisbie 5,688,234.

Frisbie discloses a method for the treatment of an occlusion in a blood vessel which includes the steps of (1) prior to performing treatment on the occlusion crossing the occlusion with a guidewire in a proximal to distal direction while aspirating blood, and (2) treating the occlusion. See column 5 lines 42-56. The prior art also teaches positioning a distal end of a guidewire proximal to at least a portion of an occlusion (5:5-13), introducing an aspiration catheter over the guidewire (5:14-24), prior to evacuating the occlusive substance from the wall of the blood vessel, aspirating through the aspiration catheter while crossing the site of the occlusion with both the distal end of the guidewire and a distal end of the aspiration catheter (5:60-63), and evacuating the occlusion (6:7-11). It is considered inherent that after the guidewire has been moved across the occluded region that either at some point during the procedure or during the removal of the device the distal end of the aspiration catheter will be moved in a distal to proximal direction.

Claims 1-2 are rejected under 35 U.S.C. 102(e) as being anticipated by Imran 5,833,650.

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Imran discloses a method for the treatment of an occlusion in a blood vessel which includes the steps of (1) prior to performing treatment on the occlusion crossing the occlusion with a guidewire in a proximal to distal direction while aspirating blood, and (2) treating the occlusion. See column 5 lines 35+.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 5, 7 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Frisbie.

With regard to claim 5, Frisbie meets the claim limitations as described above but fails to specifically teach further aspirating while moving the distal end of the aspiration catheter in a distal to proximal direction.

At the time of the invention it would have been obvious to aspirate during the totality of the procedure since the disclosure of Frisbie points to the importance of removing all of the loose fragments that may have been dislodged from the vessel wall. Continuing aspiration during removal of the device would enhance the ability to withdraw any fragments that were missed during the procedure.

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With regard to claims 7 and 13, Frisbie meets the claim limitations as describe above but fails to include using the method in the removal of an embolus from a vessel and using the method to remove an occlusion from a saphenous vein graft.

At the time of the invention, it would have been obvious to use the disclosed method to remove an embolus or remove an occlusion from a saphenous vein graft since the method as taught is capable of removing an embolus and being used in a saphenous vein graft and the method as disclosed would not have to be altered in order to achieve the desired outcome.

#### ***Allowable Subject Matter***

Claims 14-20 and 21-30 are allowed.

Claims 6 and 8-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Serke whose telephone number is 703-308-4846. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sharon Kennedy can be reached on 703-305-0154. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3590 for regular communications and 703-306-4520 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2192.



Catherine Serke  
November 2, 2001

  
Sharon Kennedy  
Primary Examiner